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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,766	11/23/2001	Sho Kuwamoto	07844-001003	5315

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FISH & RICHARDSON P.C.  
P.O. Box 1022  
MINNEAPOLIS, MN 55440-1022

EXAMINER
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RIES, LAURIE ANNE

ART UNIT	PAPER NUMBER
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2176

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/11/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/991,766		KUWAMOTO ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Laurie Ries		2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 October 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-20 and 29-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-20 and 29-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is responsive to communications: Amendment, filed 27 October 2006, to the Original Application filed 23 November 2001.
2. Claims 9-10, 19-20, and 29-30 remain rejected under 35 U.S.C. 103(a) as being unpatentable over McClendon (U.S. Patent 6,625,619 B1, claiming priority of U.S. Provisional Application Number 60/190,225).
3. Claims 11-18 and 31-46 remain rejected under 35 U.S.C. 103(a) as being unpatentable over McClendon (U.S. Patent 6,625,619 B1, claiming priority of U.S. Provisional Application Number 60/190,225) in view of Chiang (U.S. Publication 2001/0037490 A1, claiming priority of U.S. Provisional Application Number 60/190364).
4. Claims 9-20 and 29-46 are pending. Applicant has canceled claims 1-8 and 21-28. Claims 9, 11, 19, 29, 31, and 39 are independent claims.

***Response to Arguments***

5. Applicant's arguments filed 27 October 2006 have been fully considered but they are not persuasive.

Applicant argues on Page 8 of the Instant Amendment that McClendon fails to teach a shadow file having information about the file. The Office respectfully disagrees. McClendon teaches that the companion, or shadow file, recited in Column 17, lines 64-67, contains product property data that can be pasted into an existing HTML product data sheet. The companion or shadow file contains an index of product property data, making it clear to manufacturers how the users will view their data which is contained within the original HTML file, therefore the companion or shadow file contains information about the HTML file as it relates to the product property data (See McClendon, Column 17, lines 54-63).

Applicant argues on Page 9 of the Instant Amendment that McClendon fails to teach retrieving a shadow file having a filename comprising the filename of the file. The Office respectfully disagrees. The Office maintains that it was well known in the art in the art at the time of the invention to name files associated to other files in a similar manner, such as comprising the filename or a portion of the filename of the original file. The motivation for doing so would have been to maintain the association between the original file and the associated file, such as an index file containing product property data associated to an HTML file, as discussed above.

Applicant argues on Page 10 of the Instant Amendment that McClendon in combination with Chiang fails to teach a user interface for receiving said information related to the file and not contained in the file. The Office respectfully disagrees. Chiang teaches an HTML editor, which is a web-authoring tool used to receive and edit information from a user (See Chiang Provision Application, Figure 1, and Page 2, lines 4-5). It would have been obvious to one of ordinary skill in the art at the time of the invention to receive information comprising the product property set of McClendon through an HTML editor, as taught by Chiang. The motivation for doing so would have been to allow a developer ease of graphical design and high performance in organizing and formatting the product property data to be contained within the companion or shadow file.

In response to applicant's argument that McClendon and Chiang are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, McClendon and Chiang are analogous art because they are from the same field of endeavor of generating and processing electronic data, such as HTML data.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to combine Chiang with McClendon to allow a developer ease of graphical design and high performance in organizing and formatting the product property data to be contained within the companion or shadow file.

Applicant argues on Pages 13 and 14 of the Instant Amendment that McClendon in combination with Chiang fails to teach a shadow file having information about the file. The Office respectfully disagrees. McClendon teaches that the companion, or shadow file, recited in Column 17, lines 64-67, contains product property data that can be pasted into an existing HTML product data sheet. The companion or shadow file contains an index of product property data, making it clear to manufacturers how the users will view their data which is contained within the original HTML file, therefore the companion or shadow file contains information about the HTML file as it relates to the product property data (See McClendon, Column 17, lines 54-63).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9-10, 19-20, and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClendon (U.S. Patent 6,625,619 B1, claiming priority of U.S. Provisional Application Number 60/190,225).

**As per independent claims 9, 19, and 29**, McClendon teaches a method of retrieving a file including HTML data and having a filename including retrieving the file (See McClendon, Column 3, lines 55-67).

McClendon also teaches including a shadow file, or companion file, in an XML format, having a file name that associates it with the original HTML file and containing property set information about the HTML file that is not included within the HTML file (See McClendon, Column 17, lines 64-67). McClendon does not teach expressly that the shadow or companion file includes the file name of the file, however, since it was generally well known at the time of the invention to name file containing property set data, such as an XML file associated with an HTML file, identically to the file it defines, differing only in the file extension, it would have been obvious to assume that the shadow or companion file includes the file name of the HTML file. The motivation for doing so would have been to maintain the association between the HTML file and the XML file that contains property set values pertaining to the HTML file.

**As per dependent claims 10, 20, and 30**, McClendon teaches the limitations of claims 9, 19, and 29 as described above. While McClendon does not teach expressly that that extension of the shadow or companion file begins with an "m", it was well known in the art at the time of the invention that an XML file, such as the shadow or

companion file of McClendon, is a text file that may be defined by any file extension as defined by the creator of the file.

7. Claims 11-18 and 31-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClendon (U.S. Patent 6,625,619 B1, claiming priority of U.S. Provisional Application Number 60/190,225) in view of Chiang (U.S. Publication 2001/0037490 A1, claiming priority of U.S. Provisional Application Number 60/190364).

**As per independent claim 11**, McClendon teaches a system for storing a file and information related to the file and not contained in the file including an editor having an input operatively coupled for receiving information to be contained in the file, the editor providing at an output a user interface for receiving the information and for providing the information at the editor output (See McClendon, Column 2, lines 35-44).

McClendon also teaches a shadow file keys/values manager having an input operatively coupled for receiving the information related to the file and not contained in the file, the shadow file keys/values manager providing at an output a user interface for receiving the information related to the file and not contained in the file and for providing at the shadow file keys/values manager output the information related to the file and not contained in the file (See McClendon, Column 12, lines 23-35, and Column 17, lines 64-67).

McClendon also teaches a file builder having an input coupled to the editor output, the file builder building the file responsive to the information received at the file



builder input and for storing the file via an output (See McClendon, Column 12, lines 23-30 and lines 40-46).

McClendon also teaches a shadow file builder having an input coupled to the shadow file keys/values manager for receiving the information related to the file and not contained in the file, the shadow file builder building a shadow file responsive to the information related to the file and not contained in the file and for storing in the shadow file, different from the file, via an output (See McClendon, Column 9, lines 7-65).

McClendon does not teach expressly using a web-authoring tool to receive the information. Chiang teaches the use of an HTML editor, which is a web-authoring tool. (See Chiang Provisional Application, Figure 1, and Page 2, lines 4-5). McClendon and Chiang are analogous art because they are from the same field of endeavor of generating electronic data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the web-authoring tool of Chiang with the information files of McClendon. The motivation for doing so would have been to allow the developer ease of graphical design and high performance. (See Chiang Provisional Application, Page 1, line 20). Therefore, it would have been obvious to combine Chiang with McClendon for the benefit of allowing the developer ease of graphical design and high performance to obtain the invention as specified in claim 11.

**As per dependent claim 12,** McClendon and Chiang teach the limitations of claim 11 as described above. McClendon also teaches that the information related to the file is stored in the shadow file that contains XML data and therefore uses at least one XML tag (See McClendon, Column 9, lines 60-65).

**As per dependent claim 13**, McClendon and Chiang teach the limitations of claim 11 as described above. McClendon also teaches that the file includes HTML code or data (See McClendon, Column 6, lines 50-57).

**As per dependent claim 14**, McClendon and Chiang teach the limitations of claim 11 as described above. McClendon also teaches receiving a request to open the file and automatically displaying at least a portion of the information related to the file in the shadow file related to the request (See McClendon, Column 3, lines 8-25).

**As per dependent claim 15**, McClendon and Chiang teach the limitations of claim 11 as described above. McClendon also teaches receiving a request to move the file to a destination and automatically moving at least a portion of the shadow file to the destination related to the request (See McClendon, Column 16, lines 4-30).

**As per dependent claim 16**, McClendon and Chiang teach the limitations of claim 11 as described above. McClendon also teaches that the shadow file includes a name corresponding to the name of the file (See McClendon, Column 17, lines 64-67).

**As per dependent claim 17**, McClendon and Chiang teach the limitations of claim 16 as described above. McClendon also teaches including a shadow file, or companion file, in an XML format, having a file name that associates it with the original HTML file and containing property set information about the HTML file that is not included within the HTML file (See McClendon, Column 17, lines 64-67). McClendon does not teach expressly that the shadow or companion file includes the file name of the file, however, since it was generally well known at the time of the invention to name file containing property set data, such as an XML file associated with an HTML file,

identically to the file it defines, differing only in the file extension, it would have been obvious to assume that the shadow or companion file includes the file name of the HTML file. The motivation for doing so would have been to maintain the association between the HTML file and the XML file that contains property set values pertaining to the HTML file.

**As per dependent claim 18**, McClendon and Chiang teach the limitations of claims 1, 11, and 21 as described above. Chiang also teaches that the web-authoring tool, or HTML editor, includes at least a portion of Adobe GoLive (See Chiang Provisional Application, Figure 1, and Page 2, lines 4-5). McClendon and Chiang are analogous art because they are from the same field of endeavor of generating electronic data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include Adobe GoLive as the web authoring tool or HTML editor taught by Chiang and McClendon. The motivation for doing so would have been to allow the developer ease of graphical design and high performance. (See Chiang Provisional Application, Page 1, line 20). Therefore, it would have been obvious to combine Chiang with McClendon for the benefit of allowing the developer ease of graphical design and high performance to obtain the invention as specified in claim 18.

**As per independent claims 31 and 39**, McClendon teaches a method and computer program product including receiving first information to be contained in a first file, the first information including computer source code, such as HTML code (See McClendon, Column 2, lines 35-44).

McClendon also teaches receiving second information characterizing one or more properties of the first information (See McClendon, Column 12, lines 23-35, and Column 17, lines 64-67).

McClendon also teaches storing the first file information but not the second information (See McClendon, Column 17, line 67).

McClendon also teaches storing in a second file, distinct from the first file, the second information (See McClendon, Column 17, lines 65-66).

McClendon does not teach expressly using a web-authoring tool to receive the information. Chiang teaches the use of an HTML editor, which is a web-authoring tool. (See Chiang Provisional Application, Figure 1, and Page 2, lines 4-5). McClendon and Chiang are analogous art because they are from the same field of endeavor of generating electronic data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the web-authoring tool of Chiang with the information files of McClendon. The motivation for doing so would have been to allow the developer ease of graphical design and high performance. (See Chiang Provisional Application, Page 1, line 20). Therefore, it would have been obvious to combine Chiang with McClendon for the benefit of allowing the developer ease of graphical design and high performance to obtain the invention as specified in claims 31 and 39.

**As per dependent claims 32 and 40,** McClendon and Chiang teach the limitations of claims 31 and 39 as described above. McClendon also teaches that the second information is stored in the second file contains XML data which therefore uses at least one XML tag (See McClendon, Column 17, lines 65-66).

**As per dependent claims 33 and 41,** McClendon and Chiang teach the limitations of claims 31 and 39 as described above. McClendon also teaches that the computer source code includes HTML code (See McClendon, Column 17, line 67).

**As per dependent claims 34 and 42,** McClendon and Chiang teach the limitations of claims 31 and 39 as described above. McClendon also teaches receiving a request to open the first file and automatically displaying at least a portion of the second information responsive to the request (See McClendon, Column 3, lines 8-25).

**As per dependent claims 35 and 43,** McClendon and Chiang teach the limitations of claims 31 and 39 as described above. McClendon also teaches receiving a request to move the first file to a destination and automatically moving at least a portion of the second file to the destination responsive to the request (See McClendon, Column 16, lines 4-30).

**As per dependent claims 36 and 44,** McClendon and Chiang teach the limitations of claims 31 and 39 as described above. McClendon also teaches that the second file includes a name corresponding to a name of the first file (See McClendon, Column 17, lines 64-67).

**As per dependent claims 37 and 45,** McClendon and Chiang teach the limitations of claims 36 and 44 as described above. McClendon also teaches including a shadow file, or companion file, in an XML format, having a file name that associates it with the original HTML file and containing property set information about the HTML file that is not included within the HTML file (See McClendon, Column 17, lines 64-67). McClendon does not teach expressly that the shadow or companion file includes the file

name of the file, however, since it was generally well known at the time of the invention to name file containing property set data, such as an XML file associated with an HTML file, identically to the file it defines, differing only in the file extension, it would have been obvious to assume that the shadow or companion file includes the file name of the HTML file. The motivation for doing so would have been to maintain the association between the HTML file and the XML file that contains property set values pertaining to the HTML file.

**As per dependent claims 38 and 46,** McClendon and Chiang teach the limitations of claims 31 and 39 as described above. Chiang also teaches that the web-authoring tool, or HTML editor, includes at least a portion of Adobe GoLive (See Chiang Provisional Application, Figure 1, and Page 2, lines 4-5). McClendon and Chiang are analogous art because they are from the same field of endeavor of generating electronic data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include Adobe GoLive as the web authoring tool or HTML editor taught by Chiang and McClendon. The motivation for doing so would have been to allow the developer ease of graphical design and high performance. (See Chiang Provisional Application, Page 1, line 20). Therefore, it would have been obvious to combine Chiang with McClendon for the benefit of allowing the developer ease of graphical design and high performance to obtain the invention as specified in claims 38 and 46.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more

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information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LR

*William L. Bashore*  
**WILLIAM BASHORE**  
**PRIMARY EXAMINER**